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EXAMINER

VILLECCO, JOHN M

ART UNIT

PAPER NUMBER

2622

MAIL DATE

DELIVERY MODE

04/27/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/587,117	Applicant(s) SENDA, AYUMI	
	Examiner JOHN M. VILLECCO	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 and 14 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-10, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 16, 2010 has been entered.

Response to Amendment

2. Applicant has amended claim 1 to recite the limitation of "wherein the external record device is external to the image pickup device". Thus, the external pickup device has to be external to the image pickup device itself. Previously, it wasn't required that the external record device be external to the image pickup device itself, only to call some portion of the image pickup device an external record device. However, this amendment requires that the external record device not be a part of the image pickup device. Therefore, all of the limitations have to be found within the image pickup device. However, the Examiner can not find any mentioning of a connection detection means for detecting connection to the external record device through the connection means being disposed in the image pickup device of the applicant's invention. Applicant points out pages 45, 53 and 54 as support. However, these sections only state that the CPU detects that the rechargeable battery is charging, not a connection to the external device.

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The only circuit capable of detecting connection is the power detection circuit (203) located in the cradle. Therefore, this limitation constitutes new matter.

Furthermore, applicant has failed to distinctly claim and particularly point out what they think of as their invention, since there was never disclosed a connection detection means in the image pickup device -- only the cradle. Thus, a 112, 2nd paragraph rejection is also warranted.

3. Additionally, claim 8 discloses both a connection detection means in the camera body and the external recording device. It is unclear based on the specification how such a configuration can be implemented, since applicant's specification never discloses a connection detection means in the camera body -- only the camera. Thus, the Examiner has also made a 112, 1st, enablement rejection on these claims.

4. Regarding claim 6, applicant has amended the claim to recite the limitation of "wherein the external record device is external to the image pickup device". Therefore, the external record device and the image pickup device are separate entities. Similarly to the discussion of claim 1 above, the specification never discloses a readout means for reading out image data picked up by the image pickup device through the connection means -- only that image data is received from the camera, not read out. Thus, this newly worded limitation constitutes new matter.

Furthermore, applicant has failed to distinctly claim and particularly point out what they think of as their invention, since there was never disclosed a readout means in the external record device -- only the camera. Thus, a 112, 2nd paragraph rejection is also warranted.

5. Additionally, applicant has added the word "automatically" to the claim language in an attempt to overcome the Endo reference. Applicant argues that since Endo requires user input, it is not automatic. The Examiner respectfully disagrees. After selecting a back feature, the

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images are automatically transferred to the cradle. See paragraphs 0074-0075. The fact that Endo requires a user input to select a backup does not mean that the transfer of the image data is not automatic (as claimed).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-6, 8, 10, and 13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

8. Regarding claim 1, applicant has amended the claim to recite the limitation of "wherein the external record device is external to the image pickup device". Thus, the external pickup device has to be external to the image pickup device itself. Previously, it wasn't required that the external record device be external to the image pickup device itself, only to call some portion of the image pickup device an external record device. However, this amendment requires that the external record device not be a part of the image pickup device. Therefore, all of the limitations have to be found within the image pickup device. However, the Examiner can not find any mentioning of a connection detection means for detecting connection to the external record device through the connection means being disposed in the image pickup device of the

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applicant's invention. Applicant points out pages 45, 53 and 54 as support. However, these sections only state that the CPU detects that the rechargeable battery is charging, not a connection to the external device. The only circuit capable of detecting connection is the power detection circuit (203) located in the cradle. Therefore, this limitation constitutes new matter.

9. Claims 2-5 are rejected based on their dependency to claim 1.

10. As for claim 6, applicant has amended the claim to recite the limitation of "wherein the external record device is external to the image pickup device". Therefore, the external record device and the image pickup device are separate entities. Similarly to the discussion of claim 1 above, the specification never discloses a readout means for reading out image data picked up by the image pickup device through the connection means —only that image data is received from the camera, not read out. Thus, this newly wording limitation constitutes new matter.

11. With regard to claims 10 and 13, applicant has amended the claim language to read “a step of detecting **by the image pickup device** whether or not the image pickup device is connected to the external record device”. Similarly to the arguments above, the Examiner can find no mentioning in the specification of a step of detecting a connection to the external record device by the image pickup device. Applicant points out pages 45, 53 and 54 as support. However, these sections only state that the CPU detects that the rechargeable battery is charging, not a connection to the external device. The only circuit capable of detecting connection is the power detection circuit (203) located in the cradle. Therefore, this limitation constitutes new matter.

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 8 includes the limitations of a “first connection detection means” located in the image pickup device and a “second connection detection means” located in the external record device. Applicant’s specification discloses a “second connection detection means” located in the external record device, but fails to disclose the “first connection detection means” located in the image pickup device. Applicant points out pages 45, 53 and 54 as support. However, these sections only state that the CPU detects that the rechargeable battery is charging, not a connection to the external device. The only circuit capable of detecting connection is the power detection circuit (203) located in the cradle. After a thorough review of the claims and the accompanying specification, the Examiner believes that one of ordinary skill in the art would not be enabled to make and/or use the invention as described by the applicant.

More specifically, in accordance with MPEP § 2164, the examiner has the initial burden of establishing a prima facie case of lack of enablement. The question posed when making a lack of enablement rejection is: Is the experimentation needed to practice the invention undue or unreasonable? See *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916). The test for lack of enablement was established in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) and set forth several factors which must be considered by the examiner when making a

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determination of lack of enablement. These factors can be found in MPEP § 2164.01(a).

Furthermore, the examiner need not discuss every factor. The examiner need only to focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation.

B) The nature of the invention

The inventive concept in question is the incorporation of a first connection detection means located in an image pickup device and a second connection detection means located in an external record device.

C) The state of the prior art

Upon a thorough search and examination, the Examiner has found no prior art includes connection detection devices located in both an image pickup device and an external record device. The Examiner has found prior art that has a connection detection device in either an external correction device or an image pickup device -- but not both.

D) The level of one of ordinary skill in the art

Given that there is no prior art that has been found that discloses such a feature (i.e. a connection detection device located in both the image pickup device and the external record device) one of ordinary skill in the art in the camera art would not have been enabled to make and/or use a system which incorporates a connection detection device in both the image pickup device and the external record device without undue experimentation.

F) The amount of direction provided by the inventor

Applicant's specification does disclose a connection detection device located in the external record device (power detection circuit, 203) but fails to disclose a connection detection circuit located in the image pickup device. Applicant points out pages 45, 53 and 54 as support. However, these sections only state that the CPU detects that the rechargeable battery is charging, not a connection to the external device. The only circuit capable of detecting connection is the power detection circuit (203) located in the cradle.

G) The existence of working examples

There is no mention of a working example, or any example of such a connection detection device located in the image pickup device.

H) The quantity of experimentation needed based on the disclosure

Since incorporating a connection detection device in both an image pickup device and an external record device does not appear to be well known in the art, the disclosure should be enabling enough for one of ordinary skill in the art to make and/or use the invention. As mentioned previously, the only description in the specification of a connection detection device places the connection detection device in the external record device. One of ordinary skill in the art would have to engage in undue experimentation in order to figure out how to create and implement a connection detection device in both the image pickup device and the external record device. Therefore, since the specification provides no detail on how to do so, the disclosure is

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non-enabling. See MPEP § 2164.06.

When considering all of the pertinent *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) factors, the Examiner has reached the conclusion that one of ordinary skill in the art would not be enabled to make and/or use the claimed invention without undue experimentation, particularly since the amount of direction provided by the applicant is minimal.

NOTE: For examination purposes regarding claim 8, it will be assumed that instead of a connection detection means located in the image pickup device, applicant meant to claim a battery charging detection device, since this is supported by the specification.

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 1-6, 8, 10, and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

16. Regarding claims 1, 8, 10, and 13, applicant claims a connection detection means located in the image pickup device. However, after a thorough review of the specification, the Examiner can find no mentioning of a connection detection means located in the cradle. It is clear from the specification that the connection detection means is the power detection circuit (203) or connection detection circuit (501) located in the external record device. Applicant has pointed out portions of the specification that support applicant's claim language of a connection

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detection means located in the image pickup device. However, it is noted that these sections make it clear that the first and second connection detection means are the same thing – namely the connection detection section (501) which corresponds to the power detection circuit (203), which is clearly located in the cradle. See page 64, lines 1-3 and page 64, line 24 to page 65, line

1. Although, the specification does state that there is a first and second detection means, the specification clearly states that they are both the power detection circuit (203), which is clearly located in the cradle. See Figure 1. Applicant points out pages 45, 53 and 54 as support.

However, these sections only state that the CPU detects that the rechargeable battery is charging, not a connection to the external device. The only circuit capable of detecting connection is the power detection circuit (203) located in the cradle. Thus, applicant has failed to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

17. Regarding claim 6, applicant claims a readout means located in the external record device for reading out images from the external record device upon detection of connection to an image pickup device. However, it is clear from the specification that the readout means is located in the image pickup device, not the external record device and that images stored in the camera are only read from the camera to the external record device. See pages 53-54. Therefore, applicant has failed to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim Rejections - 35 USC § 102

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

19. **Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Aizawa**

(Japanese Publ. No. 2000-137796 A). U.S. Patent No. 6,832,275 will be used in the discussion of the claims, since it claims priority to Aizawa.

20. Regarding *claim 1*, Aizawa discloses an information input system and storage medium for storing image data. More specifically and as it relates to the applicant's claims, Aizawa discloses an image pickup device (CCD, col. 5, line 5); a control means (controller, 102a) for permitting image data to be recorded in a given record medium (interpreted to be both DRAM and storage mediums 103 and 104) or an external record device (PC, 101), wherein the external record device is external to the image pickup device (Fig. 1), connection means (cable; col. 5, line 18) for connection to the external record device (PC, 101); connection detection means (connection detector, 106) for detecting a connection to the external record device (PC, 101) through the connection means (cable); and transfer processing means (controller, 102a) for automatically transferring the image data, to the external record device in response to detection of connection. See column 6, lines 5-60.

21. As for *claim 2*, in Aizawa the only time image data can be transferred to the PC is when the camera and PC are connected through the cable.

22. With regard to *claims 3 and 4*, Aizawa discloses a judgment means (recording state detector, 105) for making judgment depending upon a size of image data (inherent) and an available memory of the recording medium whether or not the record medium is able to store the image data, and wherein the control means allows the image data to be saved in the record medium

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or to be transferred depending upon the judgment result. See column 6, lines 5-60. Furthermore, Aizawa discloses storing the image data in the memory of the camera when there is free space in the recording medium. See Figure 3.

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. **Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endo (U.S. Publ. No. 2002/0051639) in view of Terane (U.S. Publ. No. 2003/0076440) and further in view of Nanba (U.S. Patent No. 6,297,870).**

25. Regarding *claims 9 and 12*, Endo discloses a camera connected to a cradle in which images stored in the camera can be transferred to the cradle for backup. More specifically and as it relates to the applicant's claims, Endo discloses an image pickup means (image pickup, 14) for picking up an image; control means (CPU, 20) for permitting image data, corresponding to the image picked up by the image pickup means (image pickup, 14) to be recorded in a given record medium (flash memory, 34) or a given external record device (cradle, 50); connection means (power supply connector, 52, and data connector, 54) for connection to the external record device (cradle, 50); connection detecting means (power supply detection circuit, 60) for detecting a connection to the external record device (cradle, 50) through the connection means; and transfer processing means (control, 64) controlled by the control means (CPU, 20) for

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transferring the image data, recorded in the record medium (flash memory, 34) to the external record device when the connection detection means detects the connection to the external record device. See paragraphs 0056 and 0064 and 0074. Endo discloses the ability to detection a connection of the image pickup device to the cradle (50). Transfer can only occur when connection of the image pickup device to the cradle is detected. Thus, in response to that detection the image data can be transferred.

Endo, however, fails to explicitly disclose judgment means for making judgment depending on a size of the image data and an available memory of the record medium whether or not the record medium is able to store the image data; wherein the control means allows the image data to be saved in the record medium or to be transferred to the external record device through the transfer processing means depending on a judgment result of the judgment means. This feature implies that the camera is capable of capturing an image when placed in the cradle. Terane discloses that it is well known in the art to allow a camera to capture an image when place in a cradle. See Figure 7 and paragraphs 0117-0123. Such a feature would allow for the capture of an image while the camera is charging. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the camera of Endo to capture an image while it is positioned in the cradle.

Furthermore, Nanba discloses that it is well known to store an image to external memory if there is not enough internal memory to store it. More specifically, Nanba discloses a camera (1) connectable to an external storage device (computer, 1000). When it is judged that the memory card of the camera can not hold a captured image, an image is transferred to the PC (1000) for storage. See Figures 6A and 6B and column 7, line 32 to column 8, line 23. Nanba

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discloses that if there is sufficient memory in the recording medium (memory card, 8) then the image is stored in the memory card, not the computer (1000). See Figures 6A and 6B.

Therefore, it would have been obvious to one of ordinary skill in the art to store an image into external memory if there is not enough memory in the internal memory in the camera of Endo so that the image capturing operation can be successfully carried out. See column 10, lines 1-10.

26. Claims 10 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kayanuma (U.S. Patent No. 7,167,206) in view of Aizawa (U.S. Patent No. 6,832,275).

27. Regarding *claim 10*, Kayanuma discloses a camera cradle which transfers images to the cradle. More specifically and as it relates to the applicant's claims. Kayanuma discloses a method for an image pickup system having an image pickup device (10) and an external record device (cradle, 100) comprising the steps of detecting whether or not the image pickup device (10) is connected to the external record device (100) (wherein the control circuit of the cradle automatically detects the connection; see col. 9, line 62 to column 10, line 2); transferring image data from a given recording medium (memory, 48) of the image pickup device (10) to the external record device (100) when the image pickup device is connected to the external record device (col. 9, line 62 to col. 10, line 2).

Kayanuma, however, fails to specifically disclose the claimed steps of detecting an overflow. Aizawa, on the other hand, discloses an invention in which if the memory of a camera is full, image data is transferred to a PC. More specifically and as it relates to the applicant's claims, Aizawa discloses when a connection detector (106) detects connection of a camera to a PC and a release switch is activated, the free space of a memory card is checked (S404); if

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overflow of the memory card is detected in the previous step, the captured image is recorded in the PC (S406); if no overflow of the memory card is detected, the captured image is recorded memory card (S405). See Figure 4. This allows captured image data to be saved even if the memory card is full. See column 7, lines 25-35. Therefore, it would have been obvious to one of ordinary skill in the art when capturing an image using the camera on the cradle of Kayanuma to allow the device to automatically transfer image data directly to the cradle if the memory of the camera is full and to save it in the memory if not.

28. Claim 13 is considered a computer program claim corresponding to claim 10. Please see the discussion of claim 10 above.

Allowable Subject Matter

29. Claims 11 and 14 are allowed.

30. The following is an examiner's statement of reasons for allowance:

Regarding claim 11 and 14, the primary reason for allowance is that the prior art fails to teach or reasonably suggest a step of detecting whether or not the image pickup device is connected to the hard disk device, a step of detecting that the image pickup device has a voice input, and a step of recording the image data upon decreasing a platter rotational speed of the hard disk device if the image pickup device is connected to the hard disk device and the image pickup device has the voice input when the image pickup is commanded.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

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fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. VILLECCO whose telephone number is (571)272-7319. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JOHN M. VILLECCO/
Primary Examiner, Art Unit 2622
April 24, 2010